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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,778	08/24/2001	Nikhil M. Deshpande	884.491US1	2935
21186	7590	07/01/2004		
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			EXAMINER JAMAL, ALEXANDER	
			ART UNIT 2643	PAPER NUMBER 4
DATE MAILED: 07/01/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/938,778

Applicant(s)

DESHPANDE ET AL.

Examiner

Alexander Jamal

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 August 2001.  
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-29 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

Art Unit: 2643

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 6-11** rejected under 35 U.S.C. 102(e) as being anticipated by Ogle et al. (6430604).

As per **claims 6,7**, Ogle discloses a method comprising receiving an instant message comprising text at a destination device, then converting that text into speech if the speech option is selected (in the look-up table) (Col 9 lines 43-59).

As per **claims 10,8**, claims rejected for same reasons as claim 6. Additionally, Ogle's method will receive and convert the text independently of the manner in which the sender input the text.

As per **claim 9**, when the IM is transmitted and received by another workstation (as in the traditional IM system) it will be received across a long-lived connection.

Art Unit: 2643

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claim 11** rejected under 35 U.S.C. 103(a) as being unpatentable over Ogle et al. (6430604) as applied to claim 10, and further in view of Ichikawa et al. (4975957).

As per dependant **claim 11**, Ogle discloses applicant's claim 10 but does not disclose determining whether a speech option is chosen at the origin (sender) device and when selected, converting input speech to text.

Ichikawa discloses a speech to text converter for a computer system (Col 1 lines 5-35). It would have been obvious to one of ordinary skill in the art at the time of this application to implement a speech to text converter as one of Ogle's interfaces for the purpose of allowing the user a faster and easier way of entering text to be sent.

Ogle's method in view of Ichikawa's teachings inherently comprises determining whether a speech option is selected or not for the purpose of allowing the sender to select which input method to use when sending the instant message.

5. **Claims 1-5,12-26,28-29** rejected under 35 U.S.C. 103(a) as being unpatentable over Ogle et al. (6430604), and further in view of Ichikawa et al. (4975957).

As per **claim 1**, Ogle discloses a method of transmitting an instant message comprising text (ABSTRACT). He also discloses providing a sender interface that may be any user interface (Col 4 line 48 to Col 5 line 10). However, he does not disclose determining whether a speech option is chosen at the origin (sender) device and when selected, converting input speech to text.

Ichikawa discloses a speech to text converter for a computer system (Col 1 lines 5-35). It would have been obvious to one of ordinary skill in the art at the time of this application to implement a speech to text converter as one of Ogle's interfaces for the purpose of allowing the user a faster and easier way of entering text to be sent.

Ogle's method in view of Ichikawa's teachings inherently comprises determining whether a speech option is selected or not for the purpose of allowing the sender to select which input method to use when sending the instant message.

As per **claim 14**, claim rejected for same reasons as rejection of claim 1. Additionally, Ogle discloses an instant messaging server (Col 5 lines 1-11).

As per **claim 19**, claim rejected for same reasons as rejection of claim 1. Ogle further discloses receiving an instant message comprising text at a destination device,

Art Unit: 2643

then converting that text into speech with a text-speech converter if the speech option is selected (in the look-up table) (Col 9 lines 43-59).

As per **claim 21**, claim rejected for same reasons as rejection of claim 19. The computer inherently comprises software on a signal bearing medium for the purpose of controlling the computer.

As per **claim 26**, claim rejected for same reasons as rejection of claim 19. Ogle discloses that the receiving device may be a pager (ABSTRACT).

As per dependant **claims 2,22**, the input device may be a keyboard (text) (Col 4 line 48 to Col 5 line 10).

As per dependant **claims 3,4,23,24**, claims rejected for same reason as rejection of claim 19.

As per dependant **claim 5**, claim rejected for same reason as rejection of claim 10.

As per dependant **claims 12,28**, claims rejected for same reason as rejection of claim 9.

As per dependant **claims 13,29**, Ogle discloses that the IM may be received when the user is not 'online' (a request-reply pair) (Col 2 lines 46-53).

As per dependant **claim 15**, Ogle discloses that the user workstation may be in a server/client configuration (a long lived connection) (Col 4 line 48 to Col 5 line 10).

Art Unit: 2643

As per dependant **claims 16,17**, Ogle discloses that the server may either send the IM to a destination device or drop the message when a destination-client is not connected (if an alternative mechanism is not available) (Col 3 lines 20-33).

As per dependant **claims 18,20,25**, claims rejected for same reason as rejection of claim 10.

6. **Claim 27** rejected under 35 U.S.C. 103(a) as being unpatentable over Ogle et al. (6430604) in view of Ichikawa et al. (4975957) as applied to claim 26, and further in view of Parvulescu et al (5724410).

As per **claim 27**, Ogle discloses applicant's claim 26 but does not disclose that the pager comprises a speech-text converter.

Parvulescu teaches that pagers (Col 1 lines 5-30) may comprise speech to text converters. It would have been obvious to one of ordinary skill in the art at the time of this application that Ogle's pager could comprise a speech-text converter for the purpose of allowing the user of the pager to respond to a page by using their voice.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Jamal whose telephone number is 703-305-3433. The examiner can normally be reached on M-F 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A Kuntz can be reached on 703-305-4708. The fax phone numbers for the

Application/Control Number: 09/938,778


Page 7

Art Unit: 2643

organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9315 for After Final communications.

AJ

June 24, 2004

  
CURTIS KUNTZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600